UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,987	04/19/2004	Paul A. Gassoway	063170.7003	3477

5073 7590 04/20/2007 BAKER BOTTS L.L.P. 2001 ROSS AVENUE SUITE 600 DALLAS, TX 75201-2980		EXAMINER ZEE, EDWARD

ART UNIT	PAPER NUMBER
2109	

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	04/20/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 04/20/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mike.furr@bakerbotts.com
ptomail1@bakerbotts.com

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>*19 April 2004*</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-26* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>*19 April 2004*</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date <u>*12/13/04*</u>.

4)☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   This action is in response to the original filing of April 19th, 2004. Claims 1-26 are

pending and have been considered below.

Specification

2.   The disclosure is objected to because of the following informalities: the examiner notes

that on page 7, line 6 of the specification, "Random Access Memory (RAM)", is not referred to

as object 104 as shown in figure 1 of the drawings.

        Appropriate correction is required.

Claim Objections

3.   Claims 10, 15 and 24-26 are objected to because of the following informalities: the

examiner notes the use of the acronym "HTTP" without first including a description in plain text,

as required. Appropriate correction is required.

Claim Rejections - 35 USC § 101

4.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or
> any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and
> requirements of this title.

Claims 16-23 and 26 are rejected under 35 U.S.C. 101 because the claimed invention is directed

to non-statutory subject matter. Claims 16-23 and 26 are drawn to a computer storage medium,

which the applicant has defined in the specification (page 7, lines 1-4) to encompass an

electronic transmission signal. The Office considers an electronic signal to be a form of energy.

Energy is not a series of steps or acts and this is not a process. Energy is not a physical article or

object and as such is not a machine or manufacture. Energy is not a combination of substances

and therefore not a compilation of matter. Thus, an electronic transmission signal does not fall

within any of the four categories of invention. Therefore, Claims 16-23 and 26 are not statutory.

Claim Rejections - 35 USC § 102

5.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6.   Claims 1-5, 9, 11 and 16-20 rejected under 35 U.S.C. 102(b) as being anticipated by Ji et

al. (5,623,600).

Claims 1 and 16: Ji et al. discloses a method and computer storage medium containing code for

maintaining computer security comprising:

       a. providing a signature file [column 7, lines 51-65]. The examiner notes that it is

inherent to provide a signature file when performing a signature scanning virus detection

method;

       b. receiving an incoming message from at least one client computer*(downloaded from*

the web) [column 5, lines 28-38];

      c. comparing the received incoming message with the signature file to determine whether the incoming message is malicious*(performs a version of signature scanning virus detection)* [column 7, lines 51-65];

      d. and blocking*(do not transfer file)* the incoming messages determined to be malicious from reaching a web server [column 8, lines 4-16].

Claims 2-4 and 17-19: Ji et al. discloses a method and computer storage medium as in claims 1 and 16 above and further discloses that the comparing further comprises:

      a. parsing the incoming message*(scanning the message body)* [column 10, lines 26-28]. The examiner notes that scanning the message body implies parsing the message into at least a message header and message body;

      b. converting the incoming message into an internal format*(decoding encoded portions)* [column 10, lines 57-67];

      c. comparing the converted incoming message with the signature file and determining whether the converted incoming message is malicious based on the comparison*(executes a virus-checking program)* [column 11, lines 1-2];

      d. reassembling the converted incoming message back into its original format prior to forwarding*(transmits the message)* it to the web server if it is determined that the code is not malicious*(no viruses are detected)* and forwarding*(transmits the message)* the reassembled message to the web server [column 10, lines 42-56 and column 11, lines 4-6].

Claims 5 and 20: Ji et al. discloses a method as in claims 1 and 16 above and further discloses that the signature file contains information about known system vulnerabilities [column 7, lines 51-65]. The examiner notes that it is inherent for the signature file to contain information about

vulnerabilities in order for the virus detection program to know what kind of vulnerabilities it is

scanning for.

Claim 9: Ji et al. discloses a system for maintaining computer security comprising:

a. a signature file [column 7, lines 51-65]. The examiner notes that it is inherent to

provide a signature file when performing a signature scanning virus detection method;

b. a web server*(gateway node)* [column 3, lines 52-63];

c. and a proxy machine*(proxy server)* receiving an incoming message from at least one

client computer, comparing the received incoming message with the signature file to determine

whether t he incoming message is malicious and blocking incoming messages determined to be

malicious from reaching the web server [column 4, lines 56-67].

Claim 11: Ji et al. discloses a system as in claim 9 above and further discloses that the signature

file contains information about known system vulnerabilities [column 7, lines 51-65]. The

examiner notes that it is inherent for the signature file to contain information about

vulnerabilities in order for the virus detection program to know what kind of vulnerabilities it is

scanning for.

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

8.   Claims 6-8, 12-14 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Ji et al. (5,623,600) in view of Cambridge (7,080,000).

Claims 6, 12 and 21: Ji et al. discloses a method, system and computer storage medium as in

claims 1, 9 and 16 above, but does not explicitly disclose that the signature file is made available

through a web server. However, Cambridge discloses a similar method, system and computer

storage medium and further discloses that the signature file*(antivirus database)* is made available

through a web server*(antivirus server)* [abstract]. Therefore, it would have been obvious to one

of ordinary skill in the art at the time of invention to make the signature files available through a

web server. One would have been motivated to do so in order to make signature file updates

easily accessible.

Claims 7, 13 and 22: Ji et al. discloses a method, system and computer storage medium as in

claims 1, 9 and 16 above, but does not explicitly disclose continuously updating the signature

file. However, Cambridge discloses a similar method, system and computer storage medium and

further discloses continuously updating the signature file*(antivirus data file)* [column 2, lines 63-

67]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of

invention to continuously update the signature file. One would have been motivated to do so in

order to be able to detect the latest viruses, which are constantly being created.

Claims 8, 14 and 23: Ji et al. discloses a method, system and computer storage medium as in

claims 1, 9 and 16 above, but does not explicitly disclose periodically downloading the signature

file in order to make its copy current. However, Cambridge discloses a similar method, system

and computer storage medium and further discloses periodically downloading the signature

files*(receiving a new antivirus file at one of the user computers)* in order to make its copy current

[abstract]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of

invention to periodically download the signature files. One would have been motivated to do so

in order to be able to detect the latest viruses, which are constantly being created.

9.   Claims 10, 15 and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Ji et al. (5,623,600).

Claim 10: Ji et al. discloses a system as in claim 9 above and further discloses that the proxy

machine further comprises:

        a. a message parser module for receiving, parsing*(scanning the message body)* and

converting*(decoding encoded portions)* the incoming messages into a defined format [column

10, lines 26-28 and column 10, lines 57-67]. The examiner notes that scanning the message

body implies parsing the message into at least a message header and message body.

        b. a message analyzer module for comparing the converted incoming messages with the

signature file*(executes a virus-checking program)* [column 11, lines 1-2];

        c. and a message reassembly module for reassembling the converted incoming messages

determined not to be malicious*(no viruses are detected)* into their original format and forwarding

them to the web server*(transmits the message)* [column 10, lines 42-56 and column 11, lines 4-

6].

However, Ji et al. does not explicitly disclose that the message parser, analyzer and reassembly

modules are HTTP message parser, analyzer and reassembly modules. Nonetheless, it would

have been obvious to one of ordinary skill in the art at the time of invention to employ an HTTP

message parser, analyzer and reassembly modules. One would have been motivated to do so in

order to capable of processing HTTP messages instead of other forms of electronic messages,

depending on the intended application of the system.

Claim 15: Ji et al. discloses a system as in claim 10 above and further discloses that the

signature file is linked to the HTTP message analyzer module *(executes a virus-checking*

program) [column 11, lines 1-2]. The examiner notes that it is inherent for the HTTP message

analyzer to be linked to the signature file if it is using the signature file to scan for viruses.

Claims 24-26: Ji et al. disclose a method, system and computer storage medium as in claims 1, 9

and 16 above, but does not explicitly disclose that the incoming message comprises an HTTP

messages. However, it would have been obvious to one of ordinary skill in the art at the time of

invention for the incoming messages to be comprised of HTTP messages. One would have been

motivated to do so in order to be capable of processing HTTP messages instead of other forms of

electronic messages, depending on the intended application of the system.

Conclusion

10.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure. Hypponen et al. (6,577,920), Schnurer et al. (5,842,002) and Gluck et al.
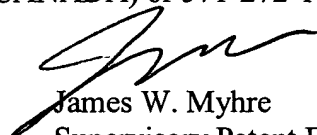
(5,948,104).

        Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Edward Zee whose telephone number is (571) 270-1686. The

examiner can normally be reached on Monday through Thursday 6:30AM-5:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, James W. Myhre can be reached on (571) 270-1065. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

EZ
April 12, 2007

James W. Myhre
Supervisory Patent Examiner

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